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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,747	10/05/2000	Yuji Natori	2271/63282	9093

7590 06/30/2003

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EXAMINER

YAN, REN LUO

ART UNIT PAPER NUMBER

2854

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/679,747

Applicant(s)

NATORI ET AL.

Examiner

Ren L Yan

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-15 and 18 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's election with traverse of Group II, claims 13-15 and 18 in Paper No. 17 is acknowledged. The traversal is on the ground(s) that all of the claimed inventions are sufficiently related to each other to be examined in one patent application. This is not found persuasive because related inventions could still be distinct from each other as pointed out by the Examiner in the restriction requirement. Since applicant's reply does not dispute the fact that Group I claims and Group II claims represent two distinct inventions, the restriction requirement set forth in the prior Office action is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claim 14 is objected to because the recitation of "the weight ratio of said first resin to said second resin" does not find proper antecedent basis. Perhaps --the weight ratio of said first solvent to said second solvent-- is what was intended by the applicant.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 13-15 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka(6,050,183).

With respect to claim 13, Tanaka teaches a method of preparing a heat-sensitive stencil as claimed including applying a wet coating composition to a surface of a resin film 20, the wet composition containing a resin, a first solvent capable of dissolving the resin and a second solvent substantially incapable of dissolving the resin, heating the composition at a temperature below a boiling point of the second solvent and sufficient to vaporize part of the first solvent, and drying the applied composition by applying heat to the composition at a temperature sufficient to vaporize the first and second solvents to form a thin resin layer and a porous layer on the surface of the resin film. See column 4, line 37 through column 5, line 11 in Tanaka for details. It should be pointed out that Tanaka teaches the exact method of making a heat-sensitive stencil as claimed in claim 13 using the exact same process steps and materials as recited. Accordingly, the wet coating composition applied in Tanaka, after being heated and dried, should form the thin resin layer and the porous layer simultaneously on the resin film as recited. With respect to claim 14, Tanaka teaches the weight ratio of the first solvent to the second solvent to be 40:60 to 95:5 which clearly covers the ratio of 1:1 as recited. With respect to claim 15, Tanaka teaches in column 6, lines 44-67 a second process for preparing a heat-sensitive stencil by applying a first and second coating compositions separately on the resin film and drying the coating compositions to form the thin resin layer and the porous resin layer. Tanaka also suggests to combine the first and second process methods for the fabrication of the stencil. With respect to

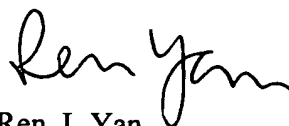
Art Unit: 2854

claim 18, Tanaka teaches the method of preparing a heat-sensitive stencil as claimed including the steps of applying a coating composition having a resin, a first solvent and a second solvent as discussed above and also the heating and drying the coating composition to form the thin resin layer and the porous layer on the surface of the resin film. Tanaka teaches the weight ratio of the first solvent to the second solvent to be in the range of 40:60 to 95:5 which falls right inside the range of 13:1 to 20:1 as recited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L Yan whose telephone number is 703-308-0978. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 703-305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Ren L Yan  
Primary Examiner  
Art Unit 2854

Ren Yan  
June 26, 2003